

## REMARKS

Claims 2-11, 13-25 are pending in the application. Claims 1 and 12 were cancelled. Claims 2, 4-7, 10, 11, 13, 15-18, and 21-23 were amended. Support for the amendment may be found throughout the specification. Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page is captioned "Version with marking to show changes made."

### *Rejections under 35 U.S.C. § 102(e)*

Claims 1-5, 12-16, 23 and 25 were rejected under 35 U.S.C. § 102(e) as being anticipated by Ameen et al, United States Patent 5,591,034. The Applicant respectfully disagrees. The Applicant has cancelled Claim 1, thereby obviating the rejection thereto.

Regarding Claims 2, 13 and 23, the Examiner references FIG. 1, Col 5, lines 5-65 and Col 9, lines 9-19 and 45-57 of Ameen for teaching of ceramic ferromagnetic material and magnetic shielding alloy. However, none of the referenced portions, nor anywhere else in the submitted references, teach or suggest these materials. Further, nowhere in the submitted references is there a teaching of shielding. Therefore, it is respectfully submitted that a *prima facie* showing of anticipation with regards to Claims 2, 13 and 23 has not been established, and withdrawal of the rejection is respectfully requested.

Regarding Claims 3 and 14, nowhere in the submitted references is such a teaching shown. Therefore, a *prima facie* showing of anticipation has not been established, and withdrawal of the rejection is respectfully requested.

Regarding Claims 4 and 15, as stated previously, shielding is not taught, suggested or even mentioned anywhere in the submitted reference. Therefore, a *prima facie* showing of anticipation has not been established, and withdrawal of the rejection is respectfully requested.

Claims 5, 16 and 25 are believed to be allowable based on dependence from an allowable claim.

*Rejections under 35 U.S.C. § 103(a)*

Claims 6-11, 17-19, 20-22 and 24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ameen et al, United States Patent 5,591,034. The Applicant respectfully disagrees.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Ryoka*, 180 U.S.P.Q. 580 (C.C.P.A. 1974). *See also In re Wilson*, 165 U.S.P.Q. 494 (C.C.P.A. 1970). Regarding Claims 6 and 17. The Examiner references Ameen and asserts that “[a] change in size is generally recognized as being within the level of ordinary skill in the art.” However, this is not a change in size, but rather, descriptions of shapes of the items, which may be utilized to provide desired shielding characteristics.

Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so. The Examiner may not use the patent application as a basis for the motivation to combine or modify the prior art to arrive at the claimed invention. *See ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 221 USPQ 929 (Fed. Cir. 1984). Therefore, it is respectfully submitted that the Examiner has utilized the present application as a template, and it is therefore respectfully requested to provide a reference or an affidavit under 37 C.F.R. 1.104(d)(2). Absent substantiation by the Examiner, it is respectfully requested that the rejection under 35 U.S.C. § 103 be withdrawn.

Regarding Claims 7-11 and 19-22 the rejection only contains the Examiner’s statement that it would be obvious “because the skilled artisan will know what dimension the item should be to match with the distance between the first surface and the second surface of the adhesive.” As the Examiner is well aware, Applicant is required to seasonably challenge statements by the Examiner that are not supported on the record, and failure to do so will be construed as an admission by Applicant that the statement is true. M.P.E.P. §2144.03. Therefore, in accordance with Applicant’s duty to seasonably challenge such unsupported statements, the Examiner is hereby requested to cite a reference supporting the position that it would have been obvious to utilize items having

the claimed dimensions. If the Examiner is unable to provide such a reference, and is relying on facts based on personal knowledge, Applicant hereby requests that such facts be set forth in an affidavit from the Examiner under 37 C.F.R. 1.104(d)(2). Absent substantiation by the Examiner, it is respectfully requested that the rejection under 35 U.S.C. § 103 be withdrawn.

Regarding Claim 24, as previously stated, there is no mention anywhere in the reference concerning shielding. The Examiner asserts that "it would have been obvious to a person having ordinary skill in the art at the time the invention was made to use between 3 microns and a millimeter length rules because it has been held by the courts that where the general conditions of the claims are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." However, as stated in *In re Swain*, the "general conditions of the claims" must be disclosed, since Ameen does not mention shielding, there would be no cause for the experimentation proposed by the Examiner. As stated by the Federal Circuit, the prior art must suggest the modifications and limitations.


The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. .... It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d 1443 (Fed. Cir. 1992) quoting *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988).

Therefore, the Examiner is respectfully requested to supply a reference or affidavit, absent such substantiation, withdrawal of the rejection is requested.

## CONCLUSION

In light of the forgoing, reconsideration and allowance of the claims is earnestly solicited.

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**VERSION WITH MARKINGS TO SHOWN CHANGES MADE**

2. (Amended) An adhesive suitable to provide a bond between components, comprising:

an adhering material suitable for holding a first surface and a second surface in contact; and

a plurality of items disposed in the adhering material, the plurality of items having electromagnetic capability (EMC) shielding characteristics [The adhesive as described in claim 1], wherein an item of the plurality of items includes at least one of ceramic ferromagnetic material and magnetic shielding alloy.

4. (Amended) The adhesive as described in claim [1]2, wherein a quantity of the plurality of items disposed in the adhering material is sufficient to provide EMC shielding between the first surface and the second surface.

5. (Amended) The adhesive as described in claim [1]2, wherein the first surface is included on an integrated circuit and the second surface is included on a heat sink.

6. (Amended) The adhesive as described in claim [1]2, wherein items of the plurality of items are shaped to include at least one of a disk, sliver, hexagonal, triangular, parallelogram, oval, diamond, polyhedral and polymorphic.

7. (Amended) An adhesive suitable to provide a bond between components, comprising:

an adhering material suitable for holding a first surface and a second surface in contact; and

a plurality of items disposed in the adhering material, the plurality of items having electromagnetic capability (EMC) shielding characteristics[The adhesive as described in claim 1], wherein an item of the plurality of items is formed wherein a longest dimension of the item is at least one of equal to

and less than one-half of a distance between the first surface and the second surface.

10. (Amended) An adhesive suitable to provide a bond between components, comprising:

an adhering material suitable for holding a first surface and a second surface in contact; and

a plurality of items disposed in the adhering material, the plurality of items having electromagnetic capability (EMC) shielding characteristics[The adhesive as described in claim 1], wherein an item of the plurality of items is formed wherein a smallest dimension of the item is at least one of equal to and less than one-tenth of a distance between the first surface and the second surface.

11. (Amended) An adhesive suitable to provide a bond between components, comprising:

an adhering material suitable for holding a first surface and a second surface in contact; and

a plurality of items disposed in the adhering material, the plurality of items having electromagnetic capability (EMC) shielding characteristics[The adhesive as described in claim 1], wherein an item of the plurality of items is formed wherein a midpoint width of the item is at least one of equal to and less than one-quarter of a distance between the first surface and the second surface.

13. (Amended) An electrical system, comprising:

a first electrical component suitable for providing a function, the first electrical component including a first surface;

a second component suitable for providing a function, the second component including a second surface;

an adhering material suitable for holding the first surface of the first electrical component and a second surface of the second component in contact; and a plurality of items disposed in the adhering material, the plurality of items having electromagnetic capability (EMC) shielding characteristics [The electrical system as described in claim 12], wherein an item of the plurality of items includes at least one of ceramic ferromagnetic material and magnetic shielding alloy.

15. (Amended) The electrical system as described in claim 1[2]3, wherein a quantity of the plurality of items disposed in the adhering material is sufficient to provide EMC shielding between the first electrical component and the second component configured as a heat sink.
16. (Amended) The electrical system as described in claim 1[2]3, wherein the first electrical component is an integrated circuit and the second component is a heat sink.
17. (Amended) The electrical system as described in claim 1[2]3, wherein items of the plurality of items are shaped to include at least one of a disk, sliver, hexagonal, triangular, parallelogram, oval, diamond, polyhedral and polymorphic.
18. (Amended) An electrical system, comprising:  
a first electrical component suitable for providing a function, the first electrical component including a first surface;  
a second component suitable for providing a function, the second component including a second surface;  
an adhering material suitable for holding the first surface of the first electrical component and a second surface of the second component in contact; and  
a plurality of items disposed in the adhering material, the plurality of items having electromagnetic capability (EMC) shielding characteristics [The electrical system as described in claim 12], wherein an item of the

plurality of items is formed wherein a longest dimension of the item is at least one of equal to and less than one-half of a distance between the first surface and the second surface.

21. (Amended) An electrical system, comprising:  
a first electrical component suitable for providing a function, the first electrical component including a first surface;  
a second component suitable for providing a function, the second component including a second surface;  
an adhering material suitable for holding the first surface of the first electrical component and a second surface of the second component in contact; and  
a plurality of items disposed in the adhering material, the plurality of items having electromagnetic capability (EMC) shielding characteristics [The electrical system as described in claim 12], wherein an item of the plurality of items is formed wherein a smallest dimension of the item is at least one of equal to and less than one-tenth of a distance between the first surface and the second surface.
22. (Amended) An electrical system, comprising:  
a first electrical component suitable for providing a function, the first electrical component including a first surface;  
a second component suitable for providing a function, the second component including a second surface;  
an adhering material suitable for holding the first surface of the first electrical component and a second surface of the second component in contact; and  
a plurality of items disposed in the adhering material, the plurality of items having electromagnetic capability (EMC) shielding characteristics [The electrical system as described in claim 12], wherein an item of the plurality of items is formed wherein a midpoint width of the item is at least one of equal to and less than one-quarter of a distance between the first surface and the second surface.



23. (Amended) An electrical system, comprising:
- a first electrical component suitable for providing a function, the electrical component including a first surface;
  - a second component including a second surface;
  - a carrier material disposed between the first electrical component and the second component; and
  - a plurality of items disposed in the carrier material, the plurality of items having electromagnetic capability (EMC) shielding characteristics, wherein an item of the plurality of items includes at least one of ceramic ferromagnetic material and magnetic shielding alloy.